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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,238

10/14/2003

Stephen Morris-Jones

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PATENT DOCUMENTATION CENTER

XEROX CORPORATION

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EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2625

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/685,238	<b>Applicant(s)</b> MORRIS-JONES ET AL.	
	<b>Examiner</b> Jerome Grant II	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### Detailed Action

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, 11, 12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Shahindoust.

With respect to claim 1, Shanhindoust teaches a method for completing a print job (steps 321, 323 and 325 of figure 3), comprising: delivering (step 321) at least one print job to a printing device 114; bringing a tag (smart card 102) containing information regarding the print job into close proximity to the printing device so that the device receives the information from the tag (step 313); using the information received from the tag to complete the print job, see para. 17, lines 18-28.

With respect to claim 2, Shanhindoust teaches wherein the information received from the tag includes printing preferences (changing position of the print preferences by the user.

With respect to claim 3, Shanhindoust teaches the tag is related to the print job, see para. 23, lines 4-8 and 15-19. See also para. 21, lines 8-14.

With respect to claim 4, Shanhindoust the tag information is necessary to complete the job, see para. 23, lines 4-8 and 15-19.

With respect to claim 5, Shanhindoust teaches wherein the tag contains decryption key (inherent with respect to the authentication module 112).

With respect to claim 8, Shanhindoust teaches wherein scanning a the includes sending a signal to the tag (see para. 17, lines 15-18) and receiving a signal (authentication module 112) containing information from the tag about the tag.

With respect to claim 11, Shanhindoust teaches the device is a scanner (copier, see para. 17, line 28).

With respect to claim 12, see para. 17, lines 13-28.

With respect to claim 15, Shanhindoust teaches a method for transferring documents from one location to another, comprising: : sending (step 321) at least one document to a queue of a printing device 114 having transmitting capabilities (either as a fax or as to printing documents to the printing device 114; bringing an electronic tag (smart card 102) containing information regarding the print job into close proximity to the tag reader operably connected to the device having document transmission capabilities (step 313, either as a fax machine or as a printing device, see para. 17, line 28); using the information received from the tag to complete the print job, see para. 17, lines 18-28.

With respect to claim 16, Shanhindoust teaches wherein the information received by the device includes a fax number to which the job is sent. This limitation is anticipated by para. 17, lines 18-28. via the multi-peripheral device which functions as a fax machine having a fax number were the numbers are discussed at lines 18-23.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanhindoust in view of the well known prior art MPEP 2144.03.

With respect to claim 17, Shahindoust teaches the use of a smart card for generating instructions for a printing operation (print job to controller 112 at step 307), see para. 21, for example.

What is not taught is the use of an E-mail address to which a job is sent.

However, the use of e-mails and the utilization of tag information to facilitate an e-mail instruction is taken from a field of technology which is well known in the art, according to paragraphs 24 and 26 of the written disclosure of the present application.

Hence, the use of e-mails for issuing instructions is well known in the art and would have been obvious to one of ordinary skill in the art to program smart chip 102 to send an e-mail address (identification of the smart-chip) to the server 100 for the purpose of controlling a print job operation.

With respect to claim 18, Shanhindoustt teaches a system for generating an advertisement (print job), comprising: a tag (102) encoded with advertising information; a tag reading device (GL 1010120, see step 313 in figure 3) for reading the tag and receiving the advertising information therefrom; an output device (printer 114) operably connected to the tag reading device, wherein the output device generates the advertisement.

Although the specific use of advertisement information is not mentioned, it would have been obvious to one of ordinary skill in the art to encode advertisement data in the tag 102. Paragraphs 24 and 26 of applicant's written description suggests that technology for reading tag information and causing specific printing operations are well known in the art.

With respect to claim 19, Shanhindoust teaches a printing device 114 as claimed, see col. 17, lines 25-28.

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With respect to claim 20, Shanhindoust teaches wherein the output device includes a fax machine (this is anticipated by the multifunctional peripheral device, see paragraph 17, lines 25-28).

With respect to claim 21, Shanhindoust teaches the output is connected to the Internet. This is at least suggested by connection to Blue-Tooth Wireless technology.

With respect to claim 22, it is inherent that the Smart Card 102 can be inserted into a user's shirt or blouse pocket (which is a type of **container**).



3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanhindoust in view of Yajima et al.

With respect to claims 6 and 7, Shanhindoust teaches all of the subject matter upon which the claim depends except for the tag being utilized in a cell phone or PDA device.

Yajima teaches a portable phone 1 which is cellular in that it is wireless. The phone 1 is used to control a print job, according to at least paragraph 53. Moreover, it is well known that a PDA may be substituted in place of a cell phone in that both devices are interchangeable wireless devices for placing instructions to a processor or network by DTMF signals generated from the keypad.

Therefore, it would have been obvious to combine the teachings of Shanhindoust with Yajima for the purpose of attaching a smart card to a cell phone or incorporating the smart-chip into a the cell phone for the purpose of instructing a print operation.

For example, Shanhindoust teaches that the tag (card 102) is the device that is linked to the print job. The card can conceivably attached by Velcro or snap so that the user of such electronic devices can scan them over the print device to inform such print device regarding the information which is on the smart card as is done by Shanhindoust.

Therefore, it would have been obvious to one of ordinary skill in the art to associated a smart card with an electronic device so that one carrying such devices may conveniently scan them over the printer to affect a print job just as the scan card 102 is swiped over the printer to affect a print operation.

With respect to claims 9 and 10, see figure 1 where wireless signals are transmitted. Although it cannot be determined if the wireless signals are radio or infrared, it would have been obvious to one of ordinary skill in the art to transmit wireless signals in a frequency that is convenient as a matter of choice, whether radio, infrared, microwave or giga-wave. One of ordinary skill would have known to transmit in a frequency range that is convenient for the application designed.

4.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanhindoust in view of Harrison.

With respect to claims 13 and 14, Shanhindoust and Harrison teach the use of codes in order to communicate information about the print job from the tag to the printer. However, the utilization of bar codes or glyph codes is not specifically stated.

Harrison appears to show a glyph or bar code 32 for controlling a print job.

The use of barcodes and glyph codes are well known in the art for sending information in a machine readable fashion for performing a specific task.

Hence, it would have been obvious to one of ordinary skill in the art to use these specific machine codes for controlling the print operation.

### **Examiner's Remarks**

At page 6 of applicant's remarks, in the first full paragraph, applicant argues that, with respect to claim 1, "...the Examiner has not shown that information such as, for example, e-mail addresses (including a billing e-mail address), fax numbers, personal printing preferences, or related print jobs are used to complete a print job." Upon close review, the examiner argues that none of these limitations appear as language in claim 1, and that applicant is arguing features not specifically set forth in claim 1.

Approximately two-thirds the way down on page 6, applicant argues, with respect to claim 15, that the examiner has failed to show: "... that Shahindoust for example, using information received from a tag to transmit a document."

But the examiner contends that the applicant has not provided an argument as to why para. 17, lines 18-28, which are the sections relied upon the examiner, does not address this feature.

With respect to applicant's arguments directed to claim 18, applicant argues that Shahindoust does not show a tag encoded with advertising information or a tag reading device that receives the advertising information therefrom.

With respect to the 103 rejections of claims 6, 7,9 and 10, applicant argues that Shahindoust does not teach incorporating information received from a tag into a print job. However, the examiner has addressed this limitation at para. 17, lines 18-28 of the Shanhindoust reference. The applicant has not provided an argument as to why this section does not address the claimed limitation.

Applicant's arguments have been considered and the rejection mailed May 1, 2008 is withdrawn in view of a new grounds of rejection.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.- Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jerome Grant II/

Primary Examiner, Art Unit 2625

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